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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/690,159	10/17/2000	Oleg B. Rashkovskiy	INTL-0472-US (P10019)	2744

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EXAMINER
VU, NGOC K

ART UNIT	PAPER NUMBER
2611	

DATE MAILED: 12/05/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/690,159	Applicant(s) RASHKOVSKIY, OLEG B.
	Examiner Ngoc K. Vu	Art Unit 2611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 October 2001* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-30* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6,8-16 and 18-30* is/are rejected.

7)☒ Claim(s) *7 and 17* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

2. Claims 1-6, 8-16, 18-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Slezak (US 6,006,257).

Regarding claim 1, Slezak teaches a method comprising: allowing the use of a content on a content receiver (viewing the primary program); automatically interrupting the use of the content; enabling the receiver to temporarily replace the content with advertising (interrupting a primary program with one or more secondary programs/advertising); determining a characteristic of the content; and selecting advertising to replace content based on the characteristic (providing the advertising based on the content of the primary program, for instance, if a viewer is watching an action movie as the primary program including a truck in a scene, secondary program can be interleaved which presents an advertisement related to a local truck dealer carrying a similar model of truck being shown in the primary program) (see col. 1, lines 14-22; col. 2, lines 9-14; col. 3, lines 45-51 and 59-62; col. 4, lines 14-28; col. 6, lines 43-47).

Regarding claims 2-6 and 8-10, Slezak teaches the limitations of determining what advertising programming to be used and when to interrupt the primary program with advertising by the database unit (see col. 2, lines 30-33; col. 3, lines 59-63; col. 5, lines 19-26; col. 6, lines 43-46).

Regarding claim 11, Slezak teaches an article comprising a medium for storing instructions (software program) that enable a processor-base system to allowing the use of a content on a content receiver (viewing the primary program); automatically interrupting the use of the content; enabling the receiver to temporarily replace the content with advertising (interrupting a primary program with one or more secondary programs/advertising); determining a characteristic of the content; and selecting advertising to replace content based on the characteristic (providing the advertising based on the content of the primary program, for instance, if a viewer is watching an action movie as the primary program including a truck in a scene, secondary program can be interleaved which presents an advertisement related to a local truck dealer carrying a similar model of truck being shown in the primary program) (see col. 1, lines 14-22; col. 2, lines 9-14; col. 3, lines 45-51 and 59-62; col. 4, lines 14-28; col. 6, lines 43-47).

Regarding claims 12-16 and 18-20, Slezak teaches the limitations of determining what advertising programming to be used and when to interrupt the primary program with advertising by the database unit (see col. 2, lines 30-33; col. 3, lines 59-63; col. 5, lines 19-26; col. 6, lines 43-46).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 21-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slezak (US 6,006,257) in view of Picco et al. (US 6,029,045).

Regarding claims 21 and 22, Slezak teaches a system comprising a receiver (set top unit 504) that receives the transmission of content (receiving a the primary program), the receiver including a shell (overlay processing unit 130) to enable the use of content to be interrupted and temporarily replace with advertising (overlay processing unit displays texts and graphics to a viewer in conjunction with or independently of the primary or secondary program currently being displayed); and storage (database unit 38) coupled to the receiver (set-top unit) storing instructions that enable the receiver determines when to interrupt the content (the primary program) with the advertising and what advertising program to use (see col. 1, lines 14-22; col. 2, lines 9-14; col. 3, lines 45-51 and 59-62; col. 4, lines 14-28; col. 6, lines 43-47; col. 8, lines 18-39). Slezak fails to teach the system is a television receiver including storage for storing the instructions that enable the receiver to determine a characteristic of the content and select advertising to replace content based on the characteristic. However, Picco discloses selecting the stored local content (advertisement) that downloaded to the set top box to insert the selected local content into the television programming data stream to provide targeted advertisement that are directed to a particular viewer (see col. 6, lines 24-41; col. 8, lines 7-22; col. 9-10, lines 67-4). Therefore, it would have been obvious to one of ordinary skill in the art to modify Slezak by including storage for storing the instructions that enable the receiver to determine a characteristic of the content and select advertising to replace content based on the characteristic at the television receiver in order to locally provide the targeted advertisement that are directed to a particular viewer.

Regarding claims 23-30, Slezak teaches the limitations of determining what advertising programming to be used and when to interrupt the primary program with advertising by the database unit (see col. 2, lines 30-33; col. 3, lines 59-63; col. 5, lines 19-26; col. 6, lines 43-46).

Allowable Subject Matter

5. Claims 7 and 17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kitsukawa et al. (US 6,282,713 B1) teaches a method and apparatus for providing on-demand electronic advertising. Kurtzman, II (US 6,044,376) teaches a method of selecting an advertisement to be shown to a user based on the content files selected and viewed by a user.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ngoc K. Vu whose telephone number is 703-306-5976. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on 703-305-4380. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-746-5967 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0377.

NV
November 29, 2001

ANDREW FAILE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600